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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,697	05/17/2000	Paul W. Chau	SPY-022-C1	8633

7590	04/04/2006

David R Graham
1337 Chewpon Ave
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EXAMINER
NGUYEN, VAN H

ART UNIT	PAPER NUMBER
2194	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/574,697	CHAU ET AL.
	Examiner	Art Unit	
	VAN H. NGUYEN	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 January 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>2-9,41,43-54 and 57-77</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>2-9,41,43-54 and 57-77</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 7-05)   Office Action Summary   Part of Paper No./Mail Date 20060330

DETAILED ACTION

1.   This Office Action is in response to the amendment filed January 26, 2006. Claims 2-9,

41, 43-54, and 57-77 are presented for examination.

Claim Rejections - 35 USC § 102

2.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

3.   Claims 2-9, 41, 43-54, and 68-76 are rejected under 35 U.S.C. 102(b) as being anticipated

by **Nara** (U.S. 5,168,151).

4.   As to claim 69, Nara teaches the invention as claimed including a portable integrated

circuit card interface device *(an IC card reader/writer 16; col.3, lines 19-20 and fig.3)*,

comprising:

means for operably connecting *(electrically connected to…when inserted from card slot)*

the interface device to an integrated circuit card *(IC card 10)* to enable communication *(reads or*

writes data from or in a memory of IC card 10) between the interface device and the integrated

circuit card *(see fig.3 and col.3, lines 21-27)*;

- means for operably connecting *(connected to)* the interface device to a host device *(a terminal/a personal computer)* to enable communication between the interface device and the host device *(see fig.3 and col.3, lines 21-27)*;

- means for operating *(off-line function)* the interface device in a standalone mode *(stand-alone mode)* in which the interface device is not operably connected *(being disconnected from)* to a host device *(a terminal/a personal computer/ an external apparatus)* to enable communication between the interface device and the host device *(col.2, lines 17-33; col.4, lines 46-51; and col.7, lines 60-67)*; and

- means for operating *(on-line function)* the interface device in a connected mode *(on-line mode)* in which the interface device is operably connected to *(connected to)* a host device *(a terminal/a personal computer/ an external apparatus)* to enable communication between the interface device and the host device *(col.2, lines 17-33; col.3, lines 27-28;col.4, lines 46-51; and col.7, lines 60-67)*.

5.   As to claim 70, Nara teaches the standalone mode comprises a mode *(off-line mode)* in which the interface device is operably connected to *(electrically connected to...when inserted from card slot)* an integrated circuit card *(IC card 10)* to enable communication *(reads or writes data from or in a memory of IC card 10)* between the interface device and the integrated circuit card *(col.2, lines 17-33; col.3, lines 17-26 ; col.4, lines 46-51; and col.7, lines 60-67)*.

6.   As to claim 71, Nara teaches a mode *(off-line mode)* in which the interface device is not operably connected *(being disconnected from)* to another device *(a terminal/a personal computer/ an external apparatus)* to enable communication therebetween *(col.2, lines 17-33; col.4, lines 46-51; and col.7, lines 60-67)*.

7.   As to claim 72, Nara teaches operably connecting *(electrically connected to...when inserted from card slot)* the interface device *(an IC card reader/writer 16)* to an integrated circuit card *(IC card 10)* to enable communication *(reads or writes data from or in a memory of IC card 10)* between the interface device and the integrated circuit card *(col.3, lines 17-26 and fig.3)*.

8.   As to claims 73, 74, and 74, refer to discussion of claim 72 above for rejection.

9.   As to claim 75, refer to discussion of claim 71 above for rejection.

10.   As to claim 43, the rejection of claim 69 above is incorporated herein in full. Additionally, Nara further teaches:

        - an application memory *(data memory 31...storing a user application program; col.3, lines 53-57; col.4, lines 25-40 and fig.3)* ;

        - an application engine for managing one or more applications in said application memory *(reads or writes data from or in memory; col.3, lines 20-27)*;

        - an input/output module *(I/O signals supplied from I/C card reader/writer 16; col.3, lines 52-67)*;

        - a host interface *(IC card reader/writer16 connected to a terminal...connected to main body of a personal computer PC; col.3, lines 27-28 and fig.3)*; and

        - one or more integrated circuit card interfaces *(IC card reader/writer 16 is electronically connected to contacts portion 11 of IC card 10; col.3, lines 19-25 and fig.3)*.

11.   As to claim 2, Nara teaches a read-only memory *(ROM 29; col.3, lines 40-53)*.

12.   As to claim 3, Nara teaches an electrically erasable programmable read-only memory *(EEPROM 29; col.3, lines 40-53)*.

13.   As to claim 4, Nara teaches said application engine further comprises a microcontroller

(display controller; col.3, line 50 and col.4, line 56).

14.   As to claim 5, Nara teaches said microcontroller further comprises said application

memory *(col.4, lines 56-60).*

15.   As to claim 6, Nara teaches said input/output module comprises a microcontroller *(I/O*

control; col.4, line 22).

16.   As to claim 7, Nara teaches said application engine further comprises a custom circuit

(circuit 21; col.3, lines 58-66).

17.   As to claim 8, Nara teaches said custom circuit further comprises said application

memory *(col.3, lines 53-57).*

18..   As to claim 9, Nara teaches said input/output module further comprises a custom circuit

(circuit 33...can be desirably set and updated by a card holder; col.4, lines 52-55).

19.   As to claim 41, Nara teaches the interface device is portable *(portable; col.10, lines 6-7*

and fig. 3).

20.   As to claim 44, Nara teaches a mode *(off-line mode)* of operation in which the interface

device is operably connected to *(electrically connected to...when inserted from card slot)* an

integrated circuit card *(IC card 10)* via one of the one or more integrated circuit card interfaces

to enable communication *(reads or writes data from or in a memory of IC card 10)* between the

interface device and the integrated circuit card *(col.2, lines 17-33; col.3, lines 17-26; col.4, lines*

46-51; and col.7, lines 60-67).

21.   As to claim 45, it includes the same limitations as in claim 71 above, and is similarly

rejected under the same rationale.

22.   As to claim 46, Nara teaches a connected mode *(on-line mode)* of operation in which the interface device is operably connected *(connected to)* to a host device *(a terminal/a personal computer)* via the host interface to enable communication between the interface device and the host device *(see fig.3 and col.3, lines 21-27)*.

23.   As to claim 47, Nara teaches during the connected mode of operation the interface device is also operably connected to *(electrically connected to…when inserted from card slot)* an integrated circuit card *(IC card 10)* via one of the one or more integrated circuit card interfaces to enable communication *(reads or writes data from or in a memory of IC card 10)* between the interface device and the integrated circuit card *(col.2, lines 17-33; col.3, lines 17-26; col.4, lines 46-51; and col.7, lines 60-67)*.

24.   As to claims 48 and 49, refer to the discussions of claims 46 and 47 above for rejections.

25.   As to claim 50, refer to the discussion of claim 71 above for rejection.

26.   As to claims 51 and 52, refer to the discussions of claims 46 and 47 above for rejections.

27.   As to claims 53 and 54, refer to the discussions of claims 46 and 47 above for rejections.

28.   As to claim 68, Nara teaches *(col.3, lines 50-52)* a display unit *(display unit 13)* and an input unit *(keyboard 12)*.

Claim Rejections - 35 USC § 103

29   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

30.   Claims 57-67 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nara in view of **Tanaka** (U.S. 5,905,245).

31.   As to claims 57, the rejections of claims 43 and 69 are incorporated herein in full. Nara

does teach the interface device *(an IC card reader/writer 16; col.3, lines 19-20 and fig.3)*. Nara,

however, does not specifically teach enable one or more programs to be added to, and/or deleted

from, the interface device.

Tanaka teaches enable one or more programs to be added to, and/or deleted from, the

interface device *(the IC card reading/writing control unit has... a pass-through function to*

control read-out/write-in processing for the IC card by an application unit in a host for the IC

card reading/writing apparatus by receiving a pass-through command from the host; see the

Abstract; col.5, lines 50-53; and col.7, line 52-col.8, line 4).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine the teachings of Tanaka and Nara because Tanaka's teaching

would have provided the capability for simplifying the configuration of the IC card system, and

largely reducing the cost required to build the system and contribute to flexibility of the

configuration of the system.

32.   As to claim 58, Nara teaches the interface device is operably connected to *(electrically*

connected to...when inserted from card slot) an integrated circuit card *(IC card 10)* via one of the

one or more integrated circuit card interfaces *(col.3, lines 17-26 and fig.3)*. Refer to the

discussion of claim 57 above for "enable one or more programs to be added to, and/or deleted

from, the interface device."

33.   As to claim 59, Nara teaches the interface device is operably connected *(connected to)* to a host device *(a terminal/a personal computer)* via the host interface *(see fig.3 and col.3, lines 26-27)*. Refer to the discussion of claim 57 above for "enable one or more programs to be added to, and/or deleted from, the interface device."

34.   As to claim 60, Nara teaches the interface device is operably connected to *(electrically connected to)* an integrated circuit card *(IC card 10)* via one of the one or more integrated circuit card interfaces *(col.3, lines 17-26 and fig.3)* and to *(connected to)* a host device *(a terminal/a personal computer)* via the host interface *(see fig.3 and col.3, lines 26-27)*. Refer to the discussion of claim 57 above for "enable one or more programs to be added to, and/or deleted from, the interface device."

35.   As to claim 61, it includes the same limitations as in claim 45 above, and is similarly rejected under the same rationale.

36.   As to claims 62-65, refer to the discussions of claims 44-47 above for rejections.

37.   As to claims 66 and 67, refer to the discussions of claims 46 and 47 above for rejections.

38.   As to claim 77, Nara teaches the interface device is also operably connected to *(electrically connected to...when inserted from card slot)* an integrated circuit card *(IC card 10)* via one of the one or more integrated circuit card interfaces to enable communication *(reads or writes data from or in a memory of IC card 10)* between the interface device and the integrated circuit card *(col.2, lines 17-33; col.3, lines 17-26; col.4, lines 46-51; and col.7, lines 60-67)*. Refer to the discussion of claim 57 above for rejection of "enable one or more programs to be added to, and/or deleted from, the interface device."

Response to Applicant's Arguments

39.   Applicant's arguments filed January 26, 2006 have been fully considered but they are not

persuasive.

        Applicant argues in substance that (a) Nara does not teach "means for operating the

interface device in a standalone mode in which the interface device is not operably connected to

a host device to enable communication between the interface device and the host device"; (b)

Nara does not teach "an integrated circuit card interface device...as recited in claim 43; and (c)

Nara and Tanaka do not teach or suggest an integrated circuit card...as recited in claim 57".

        Examiner respectfully traverses Applicant's remarks.

        As to point (a), Nara teaches means for operating *(off-line function)* the interface device in

a standalone mode *(stand-alone mode)* in which the interface device is not operably connected

(being disconnected from) to a host device *(a terminal/a personal computer/ an external*

apparatus) to enable communication between the interface device and the host device *(col.2,*

lines 17-33; col.4, lines 46-51; and col.7, lines 60-67).

        As to point (b), as shown through the mapping provided in the claim rejections, Nara

meets each limitation of claim 43.

        As to point (c), Tanaka is combined with Nara to teach enable one or more programs to

be added to, and/or deleted from, the interface device *(the IC card reading/writing control unit*

has... a pass-through function to control read-out/write-in processing for the IC card by an

application unit in a host for the IC card reading/writing apparatus by receiving a pass-through

command from the host; see the Abstract; col.5, lines 50-53; and col.7, line 52-col.8, line 4).

Conclusion

40.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Contact Information

41.   Any inquiry or a general nature or relating to the status of this application should

be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to VAN H. NGUYEN whose telephone number is (571)

272-3765.

The examiner can normally be reached on Monday-Thursday from 8:30AM

6:00PM. The examiner can also be reached on alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, WILLIAM THOMSON can be reached at (571) 272-3718.

The fax phone number for the organization where this application or

proceeding is assigned is **(571) 273-8300.**

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
Commissioner for patents
P O Box 1450
Alexandria, VA 22313-1450

Van H. Nguyen

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER